REMARKS

Claims 1 and 14 are pending in the present application. Claims 1 and 14 are independent claims.

REJECTION UNDER 35 U.S.C. §103

The Patent Office rejected Claims 1 and 14 under 35 U.S.C. §103 as being allegedly unpatentable over U.S. Patent No. 6,708,031 issued to Purnadi et al. (hereinafter "Purnadi") in view of U.S. Patent No. 6,608,832 issued to Forslow (hereinafter "Forslow"). The rejection is respectfully traversed in its entirety.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." (emphasis added) (MPEP § 2143).

Moreover, as the Patent Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Patent Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. …. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated

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> disclosures in the prior art to deprecate the claimed invention."
> (emphasis added) *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443
> (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ
> 2d 1596, 1600 (Fed. Cir. 1988).

In rejecting Claims 1 and 14, the Patent Office has alleged that col. 6, lines 26-33 of Purnadi provides motivation for combining PDSN and SGSN "in one module such as a switch" (Office Action, page 3, lines 11-16). Applicants respectfully disagree. Col. 6, lines 26-33 of Purnadi recites:

> As described above, a problem may arise wherein a particular
> wireless access network has been implemented and it is desired to
> connect the wireless access network to a packet switched core
> network with which it is not entirely compatible. As an example,
> this invention embodiment addresses a circumstance
> wherein it is desired to use a GPRS packet switched network with
> a cdma2000 wireless access network.

In other words, Col. 6, lines 26-33 of Purnadi shows the desirability to use a GPRS packet switched network with a cdma2000 wireless access network. Nowhere in Purnadi was it taught or suggested to combine PDSN and SGSN in one module such as a switch. Thus, absent the pending Claims 1 and 14, the Patent Office has failed to provide some suggestion or motivation to combine Purnadi's PDSN and SGSN in one module.

As a matter of fact, Purnadi teaches away from combining PDSN and SGSN in one module. As explained in the Amendment filed on July 14, 2006, the Packet Data Serving Node, or PDSN, is a component of a CDMA2000 mobile network. It acts as the connection point between the Radio Access and IP networks. This component is responsible for managing PPP sessions between the mobile provider's core IP network and the mobile station (read mobile phone). In other words, PDSN is a connection point between the Radio Access and IP networks. This is also shown in FIG. 4 of Purnadi, where PDSN 403 connects to the Radio Access Network 402 (via the R-P interface) and the IP network 407. Thus, PDSN is not part of the CDMA Radio Access Network (RAN). This is contrary to the Patent Office's allegation that CDMA2000 RAN (FIG. 5, element 502) includes PDSN (FIG. 4, element 403) in Purnadi (see Office Action, page 3,

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lines 3-5). To put it another way, Purnadi's FIGS. 4 and 5 show two alternative ways to connect CDMA RAN to the IP network: in FIG. 4 CDMA RAN connects to the IP network via PDSN 403, and in FIG. 5 CDMA RAN connects to the IP network via WGW 503 and SGSN 504. These are two mutually exclusive ways. Thus, Purnadi actually teaches away from combining PDSN and SGSN in one module.

At least based on these reasons, Claims 1 and 14 are allowable.

CONCLUSION

In light of the amendments contained herein, Applicants respectfully submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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